



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,159	11/13/2001	Linus Wiebe	3782-0198P	6434

2292 7590 07/28/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,159

Applicant(s)

WIEBE ET AL.

Examiner

Debra F. Charles

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

1. The disclosure is objected to because of the following informalities: on page 2 of the specification, paragraph 2, refers to the claims. The specification should avoid referencing the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1, 2,3,4,5,6, 7,8,9,10,11,12, 13, 14,17,18, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshi et al. "A Mobile Pen-

Art Unit: 3628

Based Computing system for Cellular Telephone Networks" (IEEE article dated 1993) and Morita et al. (U.S. PAT. 5969712A).

Re claims 1, 2, 3, 6, 7: Hoshi et al. disclose a method for a person to initiate an operation in a network-based system, which operation concerns goods or services indicated on a product, comprising the step of giving an instruction to the system to the effect that the operation is to be carried out using person-specific information previously stored in the system. And a hand-held device that has a unique identity with which the person-specific information is associated. an instruction to make the person.-specific information available to a party that needs to use it in connection with the carrying out of the operation. (Abstract, Introduction, 2. Requirements of Mobile Computing, page 380; 2.3 Networks for mobile computing, Fig. 1, page 381; 4.1 system specification and features, Table 1, Fig. 2, page 382; Fig. 3, p. 383.)

Hoshi et al. disclose(s) the claimed invention except by reading off a position-coding pattern in an operation field on the product by means of a hand-held device, which operation field is provided with a position-coding pattern that codes coordinates which represent said instruction in the system. However, in Abstract, Fig. 6, col. 2, lines 55-67, col. 3, lines 5-20, col. 6, lines 15-60 thereof, Morita et al. disclose(s) coordinate structure and associated reading/detecting system that effectively mirrors the position coding pattern. It would be obvious to one of

Art Unit: 3628

ordinary skill in the art to modify the invention of Hoshi et al. based on the teachings of Morita et al. The motivation to combine these references is to effectively locate the pen on the tablet for proper positioning indication.

Re claim 4: Hoshi et al. disclose the step of creating and recording electronically by means of the hand-held device graphical information that is to be attached to said instruction by passing the device across an information field on the product which information field is intended to receive the graphical information (2. Requirements of Mobile Computing, page 380, i.e. spreadsheets, drawing up documents, reports and programs are graphical information).

Re claim 5: Hoshi et al. disclose(s) the system is a payment system, the operation is a payment, the person-specific information is an account for the person and the instruction is an instruction to the effect that a payment is to be made from the account (2. Requirements of Mobile Computing, page 380, i.e. transaction processing means system is functioning as a payment system.)

Re claim 8: Hoshi et al. disclose(s) the claimed invention except the step of identifying said party comprises sending at least some of the coordinates to a first computer and of receiving in response an address in the network for the party. However, in Abstract, Fig. 6, col. 2, lines 55-67, col. 3, lines 5-20, col. 6,

Art Unit: 3628

lines 15-60, col. 14, lines 25-60, col. 17, line 8-col. 19, line 16, thereof, Morita et al. disclose(s) coordinate structure and associated reading/detecting system that effectively mirrors the position coding pattern. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. based on the teachings of Morita et al. The motivation to combine these references is to effectively locate the pen on the tablet for proper positioning indication.

Re claims 9,10, 11 and 12: Hoshi et al. disclose the step of making the person-specific information available to the party. And step of making the person-specific information available comprises creating an operation code and sending it to the party and to a second computer in the network which stores the person-specific information. And transmitting to the second computer and to the party a device identity which uniquely identifies the hand-held device and with which the person specific information is associated. And the step of making possible the carrying out of the operation comprises making the person specific information available to a party in the network-based system that needs to use it in connection with the carrying out of the operation. (1. Introduction, page 380 and Fig. 3, i.e. allows person to access personal information and keyword is the operation code).

Re claim 13: Hoshi et al. do not explicitly disclose the feature of a device identity which uniquely identifies the hand-held device. However, this feature is deemed to be inherent to the Hoshi et al. system as 2.4 Mobile client station section show

Art Unit: 3628

that calls are originated and terminated by the cellular phone. The Hoshi et al. system would be inoperative if the device did not have an identifier to uniquely identify it and distinguish it from other such devices on the wireless system.

Re claim 14: Hoshi et al. disclose the step of making the person-specific information available comprises retrieving the person-specific information, preferably from a memory in the device, and sending it to the party(1.

Introduction, page 380 and Fig. 3, i.e. allows person to access personal information and keyword is the operation code).

Re claim 17: Hoshi et al. disclose the step of sending to said party coordinates coded by the position-coding pattern and representing graphical information that was created by the user(2. Requirements of Mobile Computing, page 380, i.e. spreadsheets, drawing up documents, reports and programs are graphical information).

Re claims 18 and 19: Hoshi et al. disclose the operation is a payment. And in which the person-specific information is an account for the person and the instruction is an instruction to the effect that a payment is to be made from the account((Abstract, Introduction, 2. Requirements of Mobile Computing, page 380, i.e. transaction processing comes from an account and goes to an account; 2.3

Art Unit: 3628

Networks for mobile computing, Fig. 1, page 381; 4.1 system specification and features, Table 1, Fig. 2, page 382; Fig. 3, p. 383.)

Re claim 20: Hoshi et al. do not explicitly disclose a memory medium on which is stored a computer program comprising instructions. However, in Abstract, Fig. 6, col. 2, lines 55-67, col. 3, lines 5-20, col. 6, lines 15-60, col. 10, lines 20-35, col. 14, lines 25-60, col. 17, line 8-col. 19, line 16, thereof, Morita et al. disclose(s) a memory means to notify coincidence to conversion status output means, coordinate structure and associated reading/detecting system that effectively mirrors the position coding pattern. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. based on the teachings of Morita et al. The motivation to combine these references is to effectively locate the pen on the tablet for proper positioning indication.

4. Claims 15, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshi et al. and Morita et al. as applied to claims 6 and 12 above, and further in view of Petrovich et al. (U.S.PAT. 6101483A).

Art Unit: 3628

Re claims 15 and 16: Hoshi et al. and Morita et al. disclose(s) the claimed invention except the step of making the person-specific information available comprises identifying the person-specific information from a plurality of items of person-specific information on the basis of coordinates coded by the position-coding pattern. And the step of making the person-specific information available comprises receiving from the person a choice of the person-specific information from a plurality of items of person-specific information. However, in Abstract, col. 2, lines 25-35, col. 10, lines 60-col. 11, line 45 thereof, Petrovich et al. disclose(s) customer preferences that can be updated and transferred, along with information on shopper's store preferences. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. and Morita et al. based on the teachings of Petrovich et al. The motivation to combine these references is to personalize the pen computing system with data readily available for the user to eliminate the user's need to retype previously entered data.

Re claim 21: Hoshi et al. disclose(s) the claimed invention except hand-held device for initiating an operation concerning goods or services indicated by means of printed information on a physical product. However, in Abstract, col. 2, lines 25-35, col. 10, lines 60-col. 11, line 45 thereof, Petrovich et al. disclose(s) bar codes on products. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. based on the teachings of Petrovich et al. The

Art Unit: 3628

motivation to combine these references is to enable swift identification of products using scanners rather than data entry.

Hoshi et al. and Petrovich et al. disclose(s) the claimed invention except comprising a sensor for recording a position-coding pattern and a signal processing unit. However, in Abstract, Fig. 6, col. 2, lines 55-67, col. 3, lines 5-20, col. 6, lines 15-60, col. 14, lines 25-60, col. 17, line 8-col. 19, line 16, col. 23, lines 1-40, thereof, Morita et al. disclose(s) coordinate structure and associated reading/detecting system that effectively mirrors the position coding pattern, and an information processing unit. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. based on the teachings of Morita et al. The motivation to combine these references is to effectively locate the pen on the tablet for proper positioning indication.

5. Claims 22, 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshi et al., Morita et al. and Petrovich et al.

Re claims 22, 23, 24 and 25: Hoshi et al. disclose(s) the claimed invention except a system for making possible at least one operation in a network concerning

Art Unit: 3628

goods or services indicated on a product and a database, and network of the party being the owner of the coordinate area. However, in Abstract, col. 2, lines 25-35, col. 10, lines 60-col. 11, line 45 thereof, Petrovich et al. disclose(s) bar codes on products, a database, and an address database. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. based on the teachings of Petrovich et al. The motivation to combine these references is to enable swift identification of products using scanners rather than data entry.


Hoshi et al. and Petrovich et al. disclose(s) the claimed invention except a position-coding pattern. However, in Abstract, Fig. 6, col. 2, lines 55-67, col. 3, lines 5-20, col. 6, lines 15-60, col. 14, lines 25-60, col. 17, line 8-col. 19, line 16, col. 23, lines 1-40, thereof, Morita et al. disclose(s) coordinate structure and associated reading/detecting system that effectively mirrors the position coding pattern, and an information processing unit. It would be obvious to one of ordinary skill in the art to modify the invention of Hoshi et al. and Petrovich et al. based on the teachings of Morita et al. The motivation to combine these references is to effectively locate the pen on the tablet for proper positioning indication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on (703) 305-9779. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3628

Debra F. Charles

Examiner

Art Unit 3628
